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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/685,078
Filing Date: October 06, 2000
Appellant(s): BENNETT ET AL.

Marilyn R. Khorsandi
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 21, 2008 appealing from the Office action mailed February 20, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Applications 09/684,871, 09/680,654, 09/685,077, 09/684,861, 09/684,866, and 09/820,377 all are pending on appeal and no decisions have been rendered on the cases.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,233,568	KARA	5-2001
6,047,264	FISHER	4-2000
4,958,280	Pauly	9-1990

Intershipper, "Internet Update" Newsbytes February 18, 1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Appellant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-6, 49-52 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls et al (5,485,369) in view of Fisher et al. (6,047,264), Kara et al. (6,233,568) and InterShipper (Newsbytes Article, Internet Update).
4. With respect to Claims 1, 4, 6, 49-50, 52, and 58: Nicholls discloses the use of a shipping computer system (see abstract), with a method of using the system and a computer program located on the computer system, which instructs the computer to perform rate calculations (column 4, lines 8-24). Nicholls discloses each carrier having a set of shipping requirements and a predefined rate structure (column 2, lines 17-19, column 4, lines 49-55 and claim 1), and identifying and displaying the carriers along with the rates of services, for each of the parcels according to the rules (See Figures 4B, 4C and 4D, column 2, lines 32-38, column 7, lines 25-29 and claim 1) for each carrier. Nicholls discloses this system to be used over a global network (Column 3, lines 38-45).
5. Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of Delivery (See Figure 4A), but fails to disclose the specific delivery requirements include an electronic mail delivery notification. Fisher discloses a method for supplying automatic status updates using e-mail (See abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the electronic notification system, as disclosed by Fisher, in order to automatically send delivery status messages over e-mail without the aid or need of a human customer service representative. (See Fisher, columns 1 and 2).
6. Fisher and Nichols discloses a multiple carrier system that calculates rates for carriers with specific parameters such as a notification of delivery, however Nicholls discloses the

automatic selection of a carrier and fails to disclose determining whether a carrier would provide a specific service (such as proof of delivery which is shown by Nicholls and Fisher), and simultaneously displaying the rates of the carriers to the user. Kara discloses a computer program used for multiple shippers that determines if a carrier provides a specific service (Column 22, lines 13-48) and simultaneously displays rates for multiple carriers and calculate shipping rates of multiple services for multiple carriers (first, second, third and fourth) (See Figure 8, column 22, lines 20-38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the shipping rates of Nicholls be displayed to the user as disclosed by Kara, in order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship a particular item. (See Kara, column 22)

7. Nicholls, Fisher and Kara, disclose the use of calculating and displaying rates for specific services, for multiple carriers, but fails to disclose the simultaneous display of the rates for each carrier for each service. InterShipper is an internet, online website, where internet users can enter origin, destination, package weight and dimensions and will be displayed every method possible that you can use to ship your package for all major shippers (See Internet Update Article Page 1, Paragraphs 1-3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nicholls and Kara to display every method possible to ship a package, as disclosed by InterShipper, in order to find the cheapest shipping rate (See Page 1).

8. With respect to Claims 2, and 29: See Nicholls, Figure 4A.

9. With respect to Claims 3 and 30: See Nicholls, Column 7, lines 53-67.

10. With respect to Claims 5 and 32: Nicholls discloses displaying a rate adjustment for the special service fees (See Figure 4D).

11. Claims 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls et al (5,485,369) in view of Pauley et al. (4,958,280), Kara et al. (6,233,568), and InterShipper (Newsbytes Article, Internet Update).

12. With respect to Claims 28, 31, and 33: Nicholls discloses the use of a shipping computer system (see abstract), with a method of using the system and a computer program located on the computer system, which instructs the computer to perform rate calculations (column 4, lines 8-24). Nicholls discloses each carrier having a set of shipping requirements and a predefined rate structure (column 2, lines 17-19, column 4, lines 49-55 and claim 1), and identifying and displaying the carriers along with the rates of services, for each of the parcels according the rules (See Figures 4B, 4C and 4D, column 2, lines 32-38, column 7, lines 25-29 and claim 1) for each carrier. Nicholls discloses this system to be used over a global network (Column 3, lines 38-45).

13. Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of Delivery (See Figure 4A), but fails to specifically disclose the proof of delivery is a verbal delivery notification. Pauley discloses the use of customer service representatives which provide verbal communication of delivery status (Column 9, lines 34-38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the notification by the customer service representative, as disclosed by Pauley, in order to allow users to obtain delivery information without the use of a computer. See Pauley columns 2 and 4).

14. Nicholls and Pauley disclose a multiple carrier system that calculates rates for carriers with specific parameters such as a notification of delivery, however Nicholls discloses the automatic selection of a carrier and fails to disclose displaying the rates of the carriers to the user and determining which carriers provided a selected service. Kara discloses a computer program used for multiple shippers that determines which carriers can provide a selected service (Column 22, lines 13-48) and displays that calculate shipping rates of multiple carriers for multiple services (See Figure 8, column 22, lines 20-38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the shipping rates of Nicholls be displayed to the user as disclosed by Kara, in order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship a particular item. (See Kara, column 22)

15. Nicholls, Pauley and Kara, disclose the use of calculating and displaying rates for specific services, for multiple carriers, but fails to disclose the simultaneous display of the rates for each carrier for each service. InterShipper is an internet, online website, where internet users can enter origin, destination, package weight and dimensions and will be displayed every method possible that you can use to ship your package for all major shippers (See Internet Update Article Page 1, Paragraphs 1-3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nicholls and Kara to display every method possible to ship a package, as disclosed by InterShipper, in order to find the cheapest shipping rate (See Page 1).

16. With respect to Claim 29: See Nicholls, Figure 4A.

17. With respect to Claim 30: See Nicholls, Column 7, lines 53-67.

18. With respect to Claim 32: Nicholls discloses displaying a rate adjustment for the special service fees (See Figure 4D).

(10) Response to Argument

With respect to Appellant's argument Issue 1, Claims 49, 50, 51 and 52, Nicholls, Fisher, Kara and InterShipper do not alone or in combination teach "determining/identifying carriers that would provide the requested delivery notification service(s) for shipping a particular parcel":

The appellant argues that Kara does not disclose determining which of the carriers would provide a particular special service for a particular package, and that the basic parcel specifications and basic parameters such as class and zone, or distinguished from special services, and that the Kara fails to disclose this information being used for a particular package. Kara discloses the use of a postage maker, which is used to calculate postage for a package. Figure 8 discloses all the information for a particular package, which is entered, therefore the examiner considers this to be for a particular package. Kara, in column 22, discloses displaying multiple rates for the one particular package, and discloses that only the rates which meet the desired parameters are displayed. Nicholls discloses calculating rates for a package, which include special services (which the examiner considers to be a form of a delivery parameter), where one of the special services is proof of delivery (which the examiner discloses to be a delivery notification) or tracking. Therefore when using Nicholls, which calculates rates for a particular package with particular delivery parameters including special services and is capable of calculating a rate for multiple carriers, and combining it with Kara, which calculates rates for a particular package

with particular delivery parameters, and displays the parameters for carriers who have been determined to meet the requirements, then the combination of the references would teach determining/identifying carriers that would provide special services, such as proof of delivery (delivery notification) for shipping a particular parcel".

The appellant has argued that InterShipper does not cure the deficiency; however InterShipper is used for the simultaneous display, not for the teaching of delivery notification.

The appellant has also stated that the references of record assumes that all carriers provide special services, however this was never an assumption that was made by the examiner. Kara discloses the use of delivery parameters, and calculates "fees for a service offered by that particular service provider" and Nicholls discloses clearly in Figure 4A the use of Special services. Therefore there examiner has not relied on an assumption that all carriers provide special services, but has simply relied on the facts as stated by the references and outlined by the examiner in the rejections.

Whereas Nicholls, Kara and InterShipper do not disclose the delivery confirmation being sent by e-mail. Nicholls discloses proof of delivery, which the examiner determined to be equivalent to a delivery notification, and Fisher was used to show the use of e-mail notification of the status of the delivery. Nicholls discloses the proof of delivery/delivery notification, and Fisher discloses the status can be "when the shipment is received at the customer location" (column 2, lines 8-32), therefore the e-mail being a delivery notification, because an e-mail which states "the shipment has been received" is considered to be a delivery notification. The appellant has asserted that there is no where in Fisher that teaches the use of delivery confirmation, but rather delivery status messages over e-mail. However, as stated above, Fisher

does clearly state one of the messages is a delivery confirmation and even though Fisher may disclose more than just the delivery notification message being sent, a delivery notification message is in fact sent. Therefore when using Nicholls, which calculates rates for a particular package with particular delivery parameters including special services and is capable of calculating a rate for multiple carriers, and combining it with Kara, which calculates rates for a particular package with particular delivery parameters, and displays the parameters for carriers who have been determined to meet the requirements, and with Fisher, who teaches the proof of delivery can be in the form of an e-mail delivery confirmation, then the combination of the references would teach "determining/identifying carriers that would provide the requested delivery notification service(s) for shipping a particular parcel"

With respect to Issue 2, Claims 1, 58 and dependent claims 2-6: Nicholls, Fisher, Kara and InterShipper do not alone or in combination teach "determining/identifying carriers that would provide the requested delivery notification service(s) for shipping a particular parcel": First it should be pointed out that all the references used request information for a particular package, and do not disclose a general request, as stated by the appellant. This is shown in Nicholls, Figure 4A, and Kara Figure 8, the information is for a particular package with particular parameters. Therefore the combination of references disclose the steps being performed for a particular package.

With respect to the appellant's argument, that Nicholls, Kara, InterShipper and Fisher do not disclose determining/identifying carriers that would provide the requested delivery notification service for a particular package: **The appellant has simply repeated the**

arguments for Issue 1. Therefore, see arguments above of Nicholls, Kara, InterShipper and Fisher, teaching the claimed limitation of determining/identifying carriers that would provide the requested e-mail delivery notification service for a particular package.

With respect to Issue 3, Claims 1, 49, 50, 51, 52 and 58 and dependent Claims 2-6, Nicholls, Fisher, Kara and InterShipper do not disclose "Displaying a simultaneous identification of shipping charges for shipping the particular parcels for each delivery service offered by each respective carrier of the plurality of carriers that would provide the requested delivery notification service for the particular parcel": The appellant has asserted that for Nicholls, Fisher, Kara and InterShipper, even when considered in combination, of displaying a simultaneous identification of shipping charges for shipping a particular parcel for each delivery service offered by each respective carrier of a plurality of carriers that would provide a requested delivery notification service as claimed in one way or another by the independent and dependent claims. However as stated above, the combination of Nicholls, Kara and Fisher, would provide the step of "determining/identifying carriers that would provide the requested delivery notification service(s) for shipping a particular parcel". Kara discloses a simultaneous display for multiple carriers, but for one service at a time. InterShipper is used to disclose simultaneous display of rates for each service of each carrier which was determined by Kara, Nicholls and Fisher. Therefore the combination of all references would provide displaying a simultaneous identification of shipping charges for shipping a particular parcel for each delivery service offered by each respective carrier of a plurality of carriers that would provide a requested delivery notification service.

The appellant has submitted that InterShipper does not state that its display comprises a display of rates for each delivery service or each carrier. The appellant is arguing that "every method" means each delivery service offered by each carrier. InterShipper discloses the use of storing rates for multiple carriers and even if the term "every method" is not completely clear that it means each delivery service for each carrier. InterShipper is combined with Kara. Kara discloses a display of rates for each carrier for a particular delivery service, the examiner considers a method of delivering a package to include a type of service in which the method would use to delivery the package. Therefore the combination of Kara and InterShipper, would provide a clear simultaneous display of every service (every method) for every carrier.

The appellant is arguing that the InterShipper reference is not a publication and therefore there is not a presumption of enablement as to the disclosure of the InterShipper reference and has cited a court case stating that "finding a non-enabling promotional brochure cannot be used as a vehicle for qualifying a later filed patent as prior art". However, the examiner is not using the publication as qualifying a later filed patent as prior art. The publication can be used for what it discloses. And the Internet Update article shows InterShipper with a simultaneous display of shipping rates for each carrier for each service. The examiner has not relied on the InterShipper article for anything other than what it teaches. InterShipper discloses that Internet users can now get shipping rates from all major shippers in just a few seconds by simply entering their origin, designation, and package specification, the service will return "every method possible that you can use to ship your package". Nicholls discloses calculating for multiple services, Kara discloses calculating multiple services for multiple carriers and displays

simultaneous rates for carriers. Therefore the combination of Nicholls, Kara and InterShipper would disclose a simultaneous display of every service of every carrier.

With respect to first, second, third and forth service charges: Kara discloses multiple services and discloses 4 charges. Therefore the simultaneous display would display a first, second, third and forth charge.

With respect to Issue 4, Independent claim 28 and dependent claims 29-3s, Nicholls, Pauly, Kara and InterShipper do not disclose determining carriers that would provide verbal delivery notification for shipping a particular parcel: The appellant argues that Kara does not disclose determining which of the carriers would provide a particular special service for a particular package, and that the basic parcel specifications and basic parameters such as class and zone, or distinguished from special services, and that the Kara fails to disclose this information being used for a particular package. Kara discloses the use of a postage maker, which is used to calculate postage for a package. Figure 8 discloses all the information for a particular package, which is entered, therefore the examiner considers this to be for a particular package. Kara, in column 22, discloses displaying multiple rates for the one particular package, and discloses that only the rates which meet the desired parameters are displayed. Nicholls discloses calculating rates for a package, which include special services (which the examiner considers to be a form of a delivery parameter), where one of the special services is proof of delivery (which the examiner discloses to be a delivery notification) or tracking. Therefore when using Nicholls, which calculates rates for a particular package with particular delivery parameters including special services and is capable of calculating a rate for multiple carriers, and combining it with Kara,

which calculates rates for a particular package with particular delivery parameters, and displays the parameters for carriers who have been determined to meet the requirements, then the combination of the references would teach determining/identifying carriers that would provide special services, such as proof of delivery (delivery notification) for shipping a particular parcel".

The appellant has argued that InterShipper does not cure the deficiency; however InterShipper is used for the simultaneous display, not for the teaching of delivery notification.

The appellant has also stated that the references of record assumes that all carriers provide special services, however this was never an assumption that was made by the examiner. Kara discloses the use of delivery parameters, and calculates "fees for a service offered by that particular service provider" and Nicholls discloses clearly in Figure 4A the use of Special services. Therefore there examiner has not relied on an assumption that all carriers provide special services, but has simply relied on the facts as stated by the references and outlined by the examiner in the rejections.

Whereas Nicholls, Kara and InterShipper do not disclose the delivery confirmation being sent by e-mail. Nicholls discloses proof of delivery, which the examiner determined to be equivalent to a delivery notification, and Paulyr was used to show the use of verbal notification of the status of the delivery. Nicholls discloses the proof of delivery/delivery notification, and Pauly discloses the use of customer service representatives can give a delivery status over the phone of prescriptions (column 9, lines 34-38), therefore the examiner considers this to be a verbal delivery notification, therefore even though the system of Pauley provides for verbal confirmation upon user requests, the system would remain the same. In order for there to be any "verbal" communications, an actual person must verbally recite the status of the delivery. The

appellant does not have any structure within the claim which would lend itself to how the verbal communication is initiated. Pauley discloses that a known proof of delivery method can be a verbal communication, therefore the system as claimed, is shown to be obvious over Nicholls, Kara, Pauley and InterShipper. Therefore when using Nicholls, which calculates rates for a particular package with particular delivery parameters including special services and is capable of calculating a rate for multiple carriers, and combining it with Kara, which calculates rates for a particular package with particular delivery parameters, and displays the parameters for carriers who have been determined to meet the requirements, and with Pauley, who teaches the proof of delivery can be in the form of a verbal communication, then the combination of the references would teach "determining/identifying carriers that would provide the requested delivery notification service(s) for shipping a particular parcel"

With respect to Issue 5, Claims 28-33, Nicholls, Pauly, Kara and InterShipper do not disclose "Displaying a simultaneous identification of shipping charges for shipping the particular parcels for each delivery service offered by each respective carrier of the plurality of carriers that would provide the requested delivery notification service for the particular parcel". The appellant has asserted that for Nicholls, Pauly, Kara and InterShipper, even when considered in combination, of displaying a simultaneous identification of shipping charges for shipping a particular parcel for each delivery service offered by each respective carrier of a plurality of carriers that would provide a requested delivery notification service as claimed in one way or another by the independent and dependent claims. However as stated above, the combination of Nicholls, Kara and Fisher, would provide the step of "determining/identifying carriers that would provide the

requested delivery notification service(s) for shipping a particular parcel". Kara discloses a simultaneous display for multiple carriers, but for one service at a time. InterShipper is used to disclose simultaneous display of rates for each service of each carrier which was determined by Kara, Nicholls and Pauly. Therefore the combination of all references would provide displaying a simultaneous identification of shipping charges for shipping a particular parcel for each delivery service offered by each respective carrier of a plurality of carriers that would provide a requested delivery notification service.

The appellant has submitted that InterShipper does not state that its display comprises a display of rates for each delivery service or each carrier. The appellant is arguing that "every method" means each delivery service offered by each carrier. InterShipper discloses the use of storing rates for multiple carriers and even if the term "every method" is not completely clear that it means each delivery service for each carrier. InterShipper is combined with Kara. Kara discloses a display of rates for each carrier for a particular delivery service, the examiner considers a method of delivering a package to include a type of service in which the method would use to delivery the package. Therefore the combination of Kara and InterShipper, would provide a clear simultaneous display of every service (every method) for every carrier.

The appellant is arguing that the InterShipper reference is not a publication and therefore there is not a presumption of enablement as to the disclosure of the InterShipper reference and has cited a court case stating that "finding a non-enabling promotional brochure cannot be used as a vehicle for qualifying a later filed patent as prior art". However, the examiner is not using the publication as qualifying a later filed patent as prior art. The publication can be used for what it discloses. And the Internet Update article shows InterShipper with a simultaneous

display of shipping rates for each carrier for each service. The examiner has not relied on the InterShipper article for anything other than what it teaches. Intershipper discloses that Internet users can now get shipping rates from all major shippers in just a few seconds by simply entering their origin, designation, and package specification, the service will return "every method possible that you can use to ship your package". Nicholls discloses calculating for multiple services, Kara discloses calculating multiple services for multiple carriers and displays simultaneous rates for carriers. Therefore the combination of Nicholls, Kara and Intershipper would disclose a simultaneous display of every service of every carrier.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Jamisue A. Plucinski/

Primary Examiner, Art Unit 3629

Conferees:

/John G. Weiss/

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